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| 10/828,377 | 04/20/2004 | Erik A. Knight | 014208.1642 (93-03-020) | 4825 |
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| BAKER BOTTS L.L.P. | | | STERRETT, JONATHAN G | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOmail2@bakerbotts.com
PTOmail4@bakerbotts.com

| | | | |
|------------------------------|-----------------------------------------|----------------------------------------|--|
| Office Action Summary | Application No. 10/828,377 | Applicant(s) KNIGHT, ERIK A. | |
| | Examiner JONATHAN G. STERRETT | Art Unit 3623 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12-8-08.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1-27-09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Summary

1. This **Final Rejection** is responsive to 8 December 2008. Currently Claims 1-20 are pending.

Response to Amendments

2. The 35 USC 101 rejection of Claim 19 is withdrawn.

Response to Arguments

3. The applicant's arguments have been fully considered but are not persuasive.

The applicant argues that the claim is statutory because it generates a visual report.

The examiner respectfully disagrees.

The generating a visual report may not preempt all uses of the method, however, that is not the issue here. The issue is providing a tie to a particular apparatus in the claims. Because claim 7 lacks a tie to a particular apparatus (i.e. in the receiving, processing, identifying and generating steps), the claim is not statutory.

The applicant argues that the newly amended limitations are not taught by the cited references of Bloomfield and Mouritsen, however this argument is moot in view of new grounds of rejection.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 7-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 7 is rejected under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

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Here, applicant's method steps, fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be performed without the use of a particular apparatus. Thus, **Claim 7** is non-statutory. **Claims 8-12** depend on **Claim 7** and are thus similarly rejected.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Bloomfield**, Charles; "Bringing the Balanced Scorecard to Life: The Microsoft Balanced Scorecard Framework", White Paper, Insightformation, Inc., published May 2002, pp.1-34. (hereinafter **Bloomfield**) in view of **Mouritsen**, et.al. "Valuing the Future: intellectual capital supplements at Skandia", November 4, 2001, Accounting Auditing & Accountability Journal, Vol. 14, No. 4, pp.399-422 (hereinafter **Mouritsen**) and further in view of **Kakita**, Howard; Yu, Edward; "Improving Process Maturity to Compete in the

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Desktop Printer Market”, April 1998, PDMA Visions Magazine, pp.1-8, (hereinafter **Kakita**).

Regarding **Claim 1**, Bloomfield teaches:

A reporting tool for reporting innovation data, comprising: a database operable to store innovation data, the innovation data comprising information about one or more innovation capabilities of an entity;

Page 19 para 4, data from a data warehouse;

and a processor coupled to the database and operable to:

retrieve the innovation data;

page 19 para 4, data is retrieved from the data warehouse, i.e. using SQL Server™ (i.e. a processor since this software is known to run on a computer).

process the innovation data according to at least one of a plurality of metrics, the plurality of metrics representing one or more innovation goals corresponding to the entity;

para 21 para 1 and 2, the data retrieved is processed so that analyses can be made

determine a user role; and generate a report for the entity according to the user role, the report comprising the processed innovation data.

Page 16, the portal is personalized;

Page 17, Figure 3, the portal provides a report of the processed data.

Bloomfield teaches that a scorecard is an important tool for communicating and measuring how a company is measured in strategic issues important for that company's success. Bloomfield does not teach where the balanced scorecard addresses innovation issues per se (i.e. deals with innovation data).

Mouritsen teaches the need to measure the intellectual capital of a company, where the intellectual capital includes things like investments in R&D(page 403 para 1). Mouritsen teaches that the measuring of intellectual capital of a company is important in ensuring that the company is successful (see page 399 para 2). Furthermore, Skandia's intellectual capital statements (see page 404) suggest that these statements are based on data that is known regarding activities that can be measured within the company. These statements are provided within Skandia's financial report. Thus the prior art of Mouritsen by suggesting that innovation data can be presented in statements that are provided in an annual report suggests that these teachings are combinable with Bloomfield, who teaches in a broader context the advantages and need to provide balanced scorecards that address issues of strategic performance within a firm.

One of ordinary skill in the art would thus modify the teachings of Bloomfield to include where the balanced scorecard includes innovation data as taught by Mouritsen, because it would provide a way to measure the innovation capability of a company using the well-known balanced scorecard of Bloomfield.

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Mouritsen and Bloomfield implicitly suggest the need to improve a company's position because measurement using metrics implies that when metrics show insufficient performance, performance needs to be improved to show acceptable performance by the metric.

However, Mouritsen and Bloomfield do not teach:

identify one or more gaps between a desired innovation quotient and the one or more innovation capabilities of the entity based on the processed innovation data;

identify one or more solutions designed to close the one or more gaps;

Kakita teaches:

identify one or more gaps between a desired innovation quotient and the one or more innovation capabilities of the entity based on the processed innovation data;

Figure 2 page 3, this chart shows several gaps in Xerox ability to perform with respect to key product development areas.

identify one or more solutions designed to close the one or more gaps;

page 4 para 2, Xerox formed a TTM team to improve TTM performance (i.e. close the gaps on what the assessment showed about product development performance.

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thus Kakita shows what is known in the art regarding companies improving performance base on assessments using metrics and trying to improve those metrics based on implementing solutions.

It would have been obvious to modify the teachings of Mouritsen and Bloomfield regarding processing innovation data to include the steps taught by Kakita regarding using innovation data to identify gaps in performance and solutions to close those gaps, because it would have provided a predictable result in using the measured data to set goals for improving performance and then implementing steps to reach those goals based on the data.

Regarding **Claim 2**, Bloomfield teaches:

2. The reporting tool of Claim 1, the processor further operable to retrieve the innovation data by: accessing at least one of a plurality of data sources using a directory, the directory indicating the location of at least a portion of the innovation data;

Page 19 para 1 and 2, templates for gathering data from various sources is a directory of data sources – since these data sources are electronic – these templates indicate the location.

retrieving the at least a portion of the innovation data; and updating the database with the at least a portion of the innovation data.

Page 19 para 1, the data being captured is managed in a database – i.e. this implies that this data is stored in the database.

Regarding **Claim 3**, Bloomfield teaches:

3. The reporting tool of Claim 1, wherein the plurality of metrics comprises at least one of a budget allocated for innovation, a number of submitted ideas, a number of patent applications, a number of patents issued, a number of acquired trademarks, and a licensing revenue.

Page 20 Figure 5 shows a scoreboard that illustrates data being illustrated as metric values (i.e. numbers).

Regarding **Claim 4**, Bloomfield teaches:

4. The reporting tool of Claim 1, the processor further operable to process the innovation data according to the at least one of the plurality of metrics by:

identifying the at least one metric associated with an innovation program of the entity;

page 21 para 1, the average measure for a particular metric (e.g. on-time delivery) is identified.

associating a weight with each of the at least one metric; and

page 21 para 1, since the average is taken, this implies a weighted of 1 is associated with the particular metric.

determining a status of the innovation program according to the at least one weight.

Page 21 para 1, the status of the particular program being measured is determined according to the status compared to a threshold.

Regarding **Claim 5**, Bloomfield teaches:

5. The reporting tool of Claim 1, the processor further operable to generate the report for the entity according to the user role by generating a web-based display that illustrates at least some of the innovation data.

Page 20 Figure 5, This figure shows a web-based report that illustrates the data being measured.

Regarding **Claim 6**, Bloomfield teaches:

6. The reporting tool of Claim 1, wherein the user role is associated with a level of access to the innovation data.

Page 10 No 3; page 16 Facet 1, the level of access (i.e. a personalized portal) is associated with a level of access, since it provides data that shows how that person supports the overall strategy.

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Claims 7-20 recite similar limitations to those addressed by the rejection of **Claims 1-6** above, and are therefore rejected under the same rationale.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan G. Sterrett whose telephone number is 571-272-6881. The examiner can normally be reached on 8-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on 571-272-6737. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JGS 4-1-2009

/Jonathan G. Sterrett/

Primary Examiner, Art Unit 3623

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